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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/725, 023 10/02/96 HESS

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VENABLE
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IM22/1123

EXAMINER

MACKEY, J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1722

DATE MAILED: 11/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | | | |
|-----------------|------------|----------------|-------------|
| Application No. | 08/725,023 | Applicant(s) | Hess et al. |
| Examiner | Mackey, J. | Group Art Unit | 1722 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 9/13/99.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 5-9 and 14-25 is/are pending in the application.

Of the above claim(s) 24 and 25 is/are withdrawn from consideration.

Claim(s) 5-9, 14-16 and 18 is/are allowed.

Claim(s) 17 and 19-23 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 16

Interview Summary, PTO-413

Notice of References Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other _____

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1. Claims 24 and 25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 9.

Note that non-elected species claims 5-9 have been rejoined, in view of the indicated allowability of independent generic claim 14.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17 and 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 2, "the at least one die" lacks proper antecedent basis (in view of the amendment to claim 14), and should read --each die--.

In claim 19, line 10, "foe forcing means" is unclear (it should apparently read --said forcing means--).

In claim 20, line 1, "biassing" is misspelled.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Britten (U.S. Patent 3,833,333).

Britten teaches a press mold comprising a bottom mold part 18, a top mold part with a load plate 25, and a die which includes a pressure-exerting plate 35 below the load plate, suspension means 40-42 for movable suspending the pressure-exerting plate from the load plate, including spring means 42 for biasing the pressure-exerting plate in a raised position, and forcing means 45-48 between the load plate and the pressure-exerting plate for forcing the pressure-exerting plate downward, the forcing means including a pressure-medium chamber which receives a pressure medium and which comprises a flexible wall that is deformed by the pressure medium, the flexible wall being a diaphragm 47 pressing against the pressure-exerting plate. While Britten does not explicitly teach that the bottom mold part 18 includes a mold cavity, press molds having cooperating dies and mold cavities are notoriously well known in the press art, and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

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Britten, if not in fact intended, by providing the bottom mold part with a mold cavity, since such is notoriously well known in the press art for cooperation with a press die for the formation of pressed articles. It would have been further obvious to a skilled artisan to have provided the means for supplying a pressure medium in Britten as an opening in the upper plate, instead of the opening in the flexible wall as taught in Britten, since a skilled artisan would have recognized that such was equivalent means for supplying the pressure medium to the pressure chamber.

6. Claims 5-9, 14-16 and 18 are allowed.

Claim 17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

7. Applicant's arguments with respect to claims 19-23 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 305-4251. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

MACKEY/jpm
November 22, 1999

James Mackey
JAMES MACKEY
PRIMARY EXAMINER
ART UNIT 1722

11/22/99